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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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79646 7590 04/21/2009 Weaver Austin Villeneuve & Sampson LLP - IGT Attn: IGT P.O. Box 70250 Oakland, CA 94612-0250				
EXAMINER SAGER, MARK ALAN				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/964,962

Applicant(s)

PAULSEN ET AL.

Examiner

M. Sager

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 08 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-60 and 63-85 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-60 and 63-85 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Amendment

1. The Amendment received 12/08/08 amends claim 72 and cancels claims 61-62; thus, examination proceeds with claims 1-60 and 63-86.

Drawings

2. The drawing (fig 4) were received on 12/08/08. These drawings are accepted. No evidence of inherency submitted.

Claim Rejections - 35 USC § 112

3. Claims 27-86 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This holding is maintained from prior action as reiterated herein. Response to Applicant/Counsel assertions is provided below and incorporated herein. The original filed specification, including drawings and claims, fails to reasonably convey to an artisan that Applicant had possession of claimed invention at time of filing regarding removed from the flexible display at a later time' as claimed in amendment received March 2, 2006 and July 14, 2006, at least since there is no such removal disclosed. The citation proffered by Applicant's remarks of steps 100, 102, 108 and 110 as best understood pertain to display of outcome indicia at end of prior game and selection of indicia for a next/current game play; however, there is no teaching or suggestion that first indicia is removed such as removed from reel strip. Agreeably, the selected indicia in a current game may replace the image of symbol(s) in viewing window of prior game outcome based on randomly determined outcome; however, removed from the

flexible display as claimed suggests the symbol is no longer present on the reel strip and this is not disclosed, suggested and also is not inferred or inherent at least since this seems to imply a reprogramming of symbols on the reel strip in the game as the game is played. So as to be clear, the holding regards that the scope of 'removed from flexible display at a later time' includes removing the indicium by reprogramming indicia for a different game or different symbols for similar game such that reprogramming different symbols (i.e. indicia) from remote device is not taught, disclosed, suggested or inferred and such reprogramming is not inherent. Also, no player/casino selection of game(s) from a list of games is disclosed such that there is no teaching for player/casino selection of a game from a plurality of games for changing indicium based on different game selected or reprogramming of gaming machine to provide a different game or symbol set. Further, not a new issue, but rather in continuance that there is no remote reprogramming taught or disclosed also further applies to claims 32, 37, 44, and 77 regarding 'programmed to receive from a remote device programming instructions or information for changing the game play indicia available on the gaming apparatus since although the original disclosure states controller 80 may be programmed to choose indicia designed to attract a player to the slot machine 10, such as gaming instructions, or simulations of game play' in paragraph 25, this pertains to existing programming rather than reprogramming from a remote device that does not infer, imply nor is it inherent that a game machine is reprogrammed by a remote device, as presently claimed. The original disclosure does not provide adequate support for a remote device to reprogram a gaming machine as claimed or as asserted by Counsel/Applicant since the sending of signals received by I/O circuit 88 to change information in RAM(s) 86 and/or ROM(s) 82 lacks specificity as to what the signals pertain to reprogram the controller and can

merely be sending a seed value as a signal to be used by gaming machine random number generator to generate particular symbols to display. There is insufficient teaching to support presently claimed invention in amendment received Mar 2, 2006 and July 14, 2006. The Applicant/Counsel is reminded of duty to disclose at time of filing the invention in sufficient detail to put the public in possession of the claimed invention. In this case, the disclosure fails to adequately support claimed invention, as presently claimed.

4. Claims 27-86 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. This holding is maintained from prior action as reiterated herein. Response to Applicant/Counsel rebuttal is provided below and incorporated herein. Where the [paraphrased] claimed 'displaying the indicium', 'storing programming instruction or information for generating the game play indicia including the indicium' and 'select from a plurality of game play indicium the indicium to display' (or similar language) includes displaying an infinite number of indicium or selection from an infinite number of symbols (pg pub 20030060269, abstract and paragraphs 18 and 26) to display the selected indicium or storing instructions or information for generating the game play indicia including the indicium so as to generate a list of infinite number of symbols to select the indicia, the original filed specification does not enable the claimed invention with respect to displaying an infinite number of indicium or display indicium selected from an infinite number of symbols' or 'storing instructions or information for generating the game play indicia' that is generating from an infinite number of indicia. To clarify so as to be clear, the issue is with respect to an

infinite number of indicia either being displayed (a display is of limited space and thus cannot by extension contain an infinite number of elements), storing instructions or information to generate the game play indicia from an infinite number of indicia and/or selection from an infinite number of indicium for display (again, memory and/or processing capacity is limited/finite and thus by extension cannot be infinite so as to either store an infinite number of indicia for selection or process an infinite number of indicium for selection). The original specification (especially paragraphs 18 and 26), as best understood, appears to require either displaying an infinite number of display symbols (indicia) or selecting from a infinite number of symbols to display selected symbol(s); however, display, memory and processing is finite and thus such displaying of an infinite number of symbols or storing instructions or information for generating the game play indicia including the indicium where it is generating a list of an infinite number of symbols or selection from an infinite number of symbols is not enabled. The only disclosed value for a plurality of symbols in the original filed specification is infinite (abstract, paragraph 18, 26), thus each reference in claims regarding a plurality of indicium/indicia pertains to an infinite number of symbols thereby; however, there is no value for infinite.

5. Claims 27-86 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This holding is maintained from prior action as reiterated herein. Response to Applicant/Counsel remark is provided below and incorporated herein. The original filed specification, including drawings and claims, fails to reasonably convey to an artisan that

Applicant had possession of claimed invention at time of filing regarding 'displaying the indicium', 'storing programming instruction or information for generating the game play indicia including the indicium' and 'select from a plurality of game play indicia' being selection from an infinite number of symbols' (or similar language) includes displaying an infinite number of indicium or selection from an infinite number of symbols (pg pub 20030060269, abstract and paragraphs 18 and 26) to display the selected indicium or storing instructions or information for generating the game play indicia including the indicium so as to generate a list of infinite number of symbols to select the indicia, the original filed specification does not enable the claimed invention with respect to displaying an infinite number of indicium or display indicium selected from an infinite number of symbols' or 'storing instructions or information for generating the game play indicia' that is generating from an infinite number of indicia. The only disclosed value for a plurality of symbols in Applicant's original filed specification is infinite (abstract, paragraph 18, 26); however, there is no such obtainable value. To clarify so as to be clear, the issue is with respect to the written specification fails to reasonably convey to an artisan that the Applicant possessed the invention regarding an infinite number of indicia either being displayed (a display is of limited space and thus cannot by extension contain an infinite number of elements), storing instructions or information to generate the game play indicia from an infinite number of indicia and/or select from a plurality of indicia the indicium to display where the plurality is an infinite number of indicia for display (memory and/or processing capacity is limited/finite and thus by extension cannot be infinite so as to either store an infinite number of indicia for selection or process an infinite number of indicia for selection). The original specification (abstract and paragraphs 18 and 26), as best understood, appears to require either

displaying an infinite number of display symbols (indicia) or storing instruction for generating the game play indicia including the indicium that is to select from a plurality of indicia where the plurality of indicia is an infinite number of indicia; however, display, memory and processing is finite and thus such displaying of an infinite number of symbols or storing instructions or information for generating the game play indicia including the indicium where it is generating a list of an infinite number of symbols or selection from an infinite number of symbols is not demonstrated as being possessed.

6. Claims 27-86 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This holding is maintained from prior action as reiterated herein. Response to Applicant/Counsel assertions is provided below and incorporated herein.

The cited claims are indefinite since it is unclear how an infinite number of indicia are displayed or how indicium are selected from an infinite number of indicia or how the gaming apparatus stores an infinite number of indicium for selection at least since the display, memory and controller are each finite in capability, but the claimed plurality of indicia/indiciu pertains to an infinite number of indicia as the only disclosed value of a plurality and infinite is indefinite.

Response to Arguments

7. Applicant's arguments, see page 13, filed 12/08/08, with respect to double patenting have been fully considered and are persuasive. The rejection of claims 61-62 has been withdrawn.

8. Applicant's arguments, see page 16, filed 12/08/08, with respect to lack of adequate written support have been fully considered and are persuasive. The rejection of claims 54-56 and 85 has been withdrawn. In essence, argument regarding claims 54-56 and 85 (holding in

paragraph 5 of prior action) is persuasive since paragraph 26 provides support for 'chosen based upon the amount of value inserted by the user'. However, it is also noteworthy that the criteria for determining indicia for display is non-critical since original disclosure teaches in same paragraph 'the criteria for determining the indicia may be based upon any criteria'.

9. Applicant's arguments filed 12/08/08 have been fully considered but they are not persuasive. To preface response to Applicant/Counsel remarks with general comment regarding lack of adequate written description and/or lack of enablement, the following is provided.

The function of the written description requirement is to ensure that the inventor had possession of, as of the filing date of the application relied on, the specific subject matter later claimed by him or her; how the specification accomplishes this is not material. In re Herschler, 591 F.2d 693, 700-01, 200 USPQ 711, 717 (CCPA 1979) and further reiterated in In re Kaslow, 707 F.2d 1366, 707 F.2d 1366, 217 USPQ 1089 (Fed. Cir. 1983). See also MPEP § 2163 - § 2163.04. To obtain a valid patent, a patent application must be filed that contains a full and clear disclosure of the invention in the manner prescribed by 35 U.S.C. 112, first paragraph. The requirement for an adequate disclosure ensures that the public receives something in return for the exclusionary rights that are granted to the inventor by a patent. The grant of a patent helps to foster and enhance the development and disclosure of new ideas and the advancement of scientific knowledge. Upon the grant of a patent in the U.S., information contained in the patent becomes a part of the information available to the public for further research and development, subject only to the patentee's right to exclude others during the life of the patent. In exchange for the patent rights granted, 35 U.S.C. 112, first paragraph, sets forth the minimum requirements for the quality and quantity of information that must be contained in the patent to justify the

grant. As discussed in more detail below, the patentee must disclose in the patent sufficient information to put the public in possession of the invention and to enable those skilled in the art to make and use the invention. The applicant must not conceal from the public the best way of practicing the invention that was known to the patentee at the time of filing the patent application. Failure to fully comply with the disclosure requirements could result in the denial of a patent, or in a holding of invalidity of an issued patent.

In consideration of above requirements, on page 15 of filed received 12/08/08, Applicant rebuttal of holding is by way of quotes from originally filed specification that asserts that paragraphs 18 and 25-26 provide support, the Office disagrees since the cited paragraphs fail to address the issue raised. For instance, the phrase 'Furthermore, the controller 80 may be programmed to dynamically change the chosen indicia before, during or after game play to offer the user a unique gaming experience' quoted from paragraph 26 pertains to timing of selection of indicia for display; the phrase 'For example, the controller 80 may be programmed to choose indicia designed to attract a player to a slot machine 10, such as gaming instructions, or simulations of play. The controller 80 may instruct the display driver 50 to display the chosen indicia at a block 102' quoted from paragraph 25 pertains to [timing and/or] type of indicia selected of instructional or attraction display [signals]; and, the phrase 'The slot machine reel 40 may further include one or more integrated circuits 48 which process appropriate data to control display of the various indicia' quoted from paragraph 18 pertains to processing to display selected data. None of the quoted portions nor any other portion therein provides adequate support regarding dynamically change the indicium displayed ... 'removed from the flexible display at a later time' and 'changing the game play indicia available on the gaming apparatus'

as claimed since there is no disclosed dynamic programming of indicia for display and such reprogramming is not inherent since connection between gaming machine and remote device plausibly may be for providing a seed to a RNG in gaming machine to determine random outcome symbol combination to display rather remote reprogramming of indicia on reel, but neither is adequately disclosed. Also, no factual evidence [i.e. under 1.132] was submitted for consideration regarding inherency; however, if factual evidence were to be filed, the timing of filing of any such evidence is now in an after final status, that may be a new issue.

In reply to Applicant/Counsel rebuttal on pages 16-17 regarding holdings in paragraphs 6-7 of prior Office action, the Office disagrees and notes rebuttal as best understood appears to have grouped reply to two separate issues together or failed to reply to lack of enablement issue in paragraph 7 [paragraph 6 pertained to lack of adequate disclosure; while paragraph 7 pertained to lack of enablement; where the issues are separate and distinct, sic]. The remark by Applicant/Counsel that the use of the word 'infinite' merely indicates that there is an infinite number of possible choices available in regards to game play indicia, that the Applicant doesn't claim to have invented a gaming apparatus with infinite number of game play indicia or claim to have invented a device that is capable of displaying an infinite number of game play indicia at one time appears to attempt to redraft [re-write] scope of specification by remark (i.e. without amendment) after filing of specification that is strictly prohibited. The Applicant is required to disclose their invention in manner to comply with 112, first paragraph to put public in possession of what they invented at time of filing in exchange for rights of patent that in this case is maintained that Applicant failed to provide adequate written disclosure and redrafting scope of written specification after filing by comment is not persuasive and is prohibited.

Further regarding rebuttal on page 17 that the Applicant 'doesn't believe that a person of skill in the art would interpret the specification in this manner as it is not consistent with any known engineering practices' is Applicant/Counsel opinion without factual evidence and Counsel comment cannot take the place of evidence in the record. However, the issue with respect to how an artisan *may* or *may not* interpret the language is also an attempt to re-draft the specification since contrary to Applicant/Counsel opine, the Office maintains an artisan would interpret the aforementioned quoted statements from paragraphs 18 and 26 of PG-PUB 2003/060269 in manner stated in holding above incorporated herein since the quoted portions as best understood require the scope of invention of gaming apparatus to include a controller programmed to determine an infinite variety of game play indicia where the display is capable of displaying an infinite number of possible indicia relevant to game play as having an infinite number of indicia programmed to be selected/determined by the processor to be displayed as game play indicia thereby requiring the programming in memory of an infinite number of indicium for selection from the list of the infinite number of indicium so as to determine the possible indicia relevant to game play as game outcome. The quoted portion of specification from paragraph 25 and 26 as stated above pertain to type of indicia selected of instructional or attraction display [signals] and timing of selection of indicia for display, respectively. The quoted portions (and all other portions) fail to provide adequate support that the inventor had possession of the claimed invention since the only form disclosed in originally filed specification regarding select from a plurality of indicium pertains to select from an infinite variety of game play indicia that is capable of displaying an infinite number of possible indicia relevant to game play where the only disclosed value for plurality is infinite (sic). Thus as stated in holding above

incorporated herein, the claimed form of gaming apparatus for controller 'to select from a plurality of game play indicia the indicium to display' pertains to the controller 80 being programmed to determine an infinite variety of game play indicia (para 26) since it is the only form disclosed and the claimed form of gaming apparatus for [flexible] display displaying an indicium pertains to the flexible display panel 42 capable of displaying an infinite number of possible indicia relevant to game play (para 18) since it is the only form disclosed. Further, by extension, the claimed form of gaming apparatus for memory storing of instructions for generating the game play indicia including the indicium pertain to storing the infinite list of indicia that the processor uses to determine an infinite variety of game play indicia (para 26) for the display to display the infinite number of possible relevant game play indicia (para 18).

Also, as from the holding in paragraph 7 of prior action as maintained above and incorporated herein, the disclosure further fails to enable an artisan to make and/or use the invention regarding a processor, display and memory of a gaming apparatus with respect to a plurality of indicia that is an infinite number of indicia, *supra*. The quoted paragraphs 18 and 26 (and any other paragraph from original disclosure) do not enable an artisan to make/use the invention regarding a memory that stores an infinite number of indicia, regarding a processor to select from so as to determine an infinite variety of game play indicia and regarding a display that is capable of displaying an infinite number of possible indicia relevant to game play, *supra*. The only form of gaming apparatus having a plurality of indicia disclosed pertains to an infinite number of indicia thus, the claimed plurality of indicia pertains to an infinite number of indicia (*supra*). There was only Applicant/Counsel submitted opinion with no factual evidence to

support inherency. The arguments of counsel cannot take the place of evidence in the record. In re Schulze, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965).

Further, in reply to Applicant/Counsel assertion that ‘these selections are made from a plurality of symbols that the controller is capable of displaying’, the Office notes that the statement fails to address the issue of lack of adequate support of disclosed invention and lack of enablement of claimed invention; however, the Applicant/Counsel remark attempts to rewrite the scope of the specification which is prohibited. The only form for invention disclosed in originally filed specification for a plurality of symbols is an infinite number (para 18, 26). The lack of adequate written disclosure to put the public in possession of the invention regarding a memory that stores an infinite number of indicia, a processor that selects from an infinite number and a display that displays an indicium from a selection from an infinite number of indicia or displays an infinite number of indicia at least since there is no memory, processor and display capable of handling an infinite number of indicia (sic); while with respect to enablement, the disclosure fails to enable an artisan to make/use the invention regarding an infinite number of indicia being stored, processed [determined] and displayed. The issues are related but separate and distinct. The quoted sections of specification pertain to type of indicia for display or timing of selection that do not address the issues maintained herein.

In reply to Applicant/Counsel remark that the specification doesn’t teach that the gaming apparatus is programmed with an infinite number of indicium nor would one skill of the art interpret the specification as such due to it being not consistent with any known engineering practice, the Office disagrees since the remark attempts to redraft scope of originally filed specification. The remark also is Counsel/Applicant opine that fails to provide factual evidence.

The arguments of counsel cannot take the place of evidence in the record. In re Schulze, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). The only form of gaming apparatus disclosed for a processor to select from a plurality of indicia is with respect to an infinite number of indicia that is maintained as indefinite at least since infinite is not a defined value. Likewise, the only disclosed form of gaming apparatus for a memory and a display for a plurality of indicia pertains to an infinite number of indicium that similarly is indefinite. Also, the Office reply above regarding interpretation of quoted portions of specification is incorporated herein.

Conclusion

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Sager whose telephone number is 571-272-4454. The examiner can normally be reached on T-F, 0700-1730 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. Sager/
Primary Examiner, Art Unit 3714

13.